

REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-10 and 29-38 are pending. Claims 1-10 and 29-38 were rejected. Claim 10 is hereby canceled. Claim 37 is amended.

REJECTION UNDER 35 U.S.C. § 112

Claim 37 was rejected under 35 U.S.C. § 112, second paragraph as being indefinite because the units were not completely specified. Claim 37 is amended to recite "1 pound per foot³." Withdrawal of the rejection under § 112 is respectfully requested.

REJECTION UNDER 35 U.S.C. § 102

Claims 1-6, 9, 30-32 and 34-36 were rejected under 35 U.S.C. § 102 as being anticipated by Horner, Jr. et al. (US 2003/0032351). These rejections are respectfully traversed.

Claim 1 recites, "the cover layer has a thickness dimension which is substantially uniform." Horner, Jr. et al. neither discloses nor suggests this feature. Horner, Jr. et al. merely state at paragraph [0022] that, "a thickness of from about 1 to about 100 mils, preferably 2-10 mils." This could either be interpreted as a coating with variable thickness in the recited range, or as a coating having an uncontrolled thickness in the recited range. The only other mention of coating thickness is in paragraph [0045], which mentions use of a Gardner draw-down gauge set to achieve a coating thickness of 30 mils on the mat. Nowhere does Horner, Jr. et al. indicate that the resulting coating has a substantially uniform thickness. Nor does Horner, Jr. et al. inherently teach the substantially uniform thickness requirement of claim 1. **M.P.E.P. § 2112** recites:

"To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is **necessarily** present in the

thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis in original).

Given the disclosure of Horner, Jr. et al., substantially uniform thickness is NOT necessarily present in Horner, Jr. et al.'s coating. Therefore, Horner, Jr. et al. neither expressly nor inherently teaches that the cover layer has a thickness dimension which is substantially uniform, as required by claim 1. M.P.E.P § 2131 recites:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Because the substantially uniform thickness of claim 1 is not expressly or inherently described in Horner, Jr. et al., claim 1 is not anticipated by Horner, Jr. et al.

Also, Claim 1 recites, "the cover layer is permanently embedded into the body layer." An advantage of this feature is high resistance to delamination. Horner, Jr. et al. neither discloses nor suggests that his cover layer is embedded. On the contrary, Horner, Jr. et al. teaches the opposite of embedding. Paragraph [0024] of Horner, Jr. et al. recites, "Advantageously, the consistency of the foam is such that the coating mixture does not penetrate through the mat and ideally simulates the consistency of shaving cream." Further, Horner, Jr. indicates at paragraph [0022] that,

"The resulting frothed or foamed, aerated composition is then coated to a thickness of from about 1 to about 100 mils, preferably 2-10 mils, on the preformed mat surface under ambient conditions using a knife blade, a roller or any other convenient method of application. In one aspect, the foam coated mat is then dried at below its cure temperature to provide a foamed, self-supporting product having a reduced coating thickness of up to 90 mils which adheres to the mat surface. " [emphasis added].

Horner, Jr. et al. clearly teaches that his coating is on the mat surface, and adheres to the mat surface. Paragraph [0027] further recites, "Additionally, where the foamed coating on the facer is dried and/or cured, the bonding strength between the uncoated fibers and the core material in the resulting product is enhanced due to reduced penetration of the coating mixture into the mat by reason of its prefoamed state." By teaching away from penetration, Horner, Jr. et al. teaches away from a cover layer permanently embedded into the body layer, as required by claim 1.

Further, one of ordinary skill in the art would have understood from Horner, Jr. et al.'s disclosure, that the coating was not embedded in the body layer, as required by Applicant's claim 1. Horner, Jr. et al. speaks throughout his disclosure of the cold temperature delamination problem. See for example, paragraphs [0006], [0008], [0012], [0027], and [0037]. The concern with cold temperature delamination arises because Horner, Jr. et al. DO NOT embed the coating into their body layer, as required by Applicants' claim 1. Horner, Jr.'s coating sits on top of his mat, which is the reason that delamination is such a concern. Further, Horner, Jr. et al. teach that retention of heat during curing is needed to eliminate the delamination problem, which further demonstrates that Horner, Jr. et al. did not teach embedding the coating in the mat, which would have eliminated the need for retention of heat during curing.

Therefore, the rejection of claim 1 should be withdrawn. Claims 2-6, 9, 30-32 and 34-36 are dependent on claim 1, and are not anticipated for at least the same reasons. Withdrawal of the rejections of claims 1-6, 9, 30-32 and 34-36 is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 29 and 38 were rejected under 35 U.S.C. § 102 as being anticipated by, or under 35 U.S.C. § 103 as being unpatentable over, Horner, Jr. et al. This rejection is respectfully traversed.

Claim 29 recites, "a cover layer of substantially uniform thickness permanently embedded in the face of the body layer." Although claim 29 includes process limitations, these are structural elements. Thus, claim 29 is not anticipated by Horner, Jr. et al. for the same

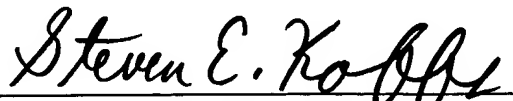
reasons set forth above with reference to claim 1. Further, Horner, Jr. et al. teaches away from these features of claim 29, because Horner, Jr. et al. teaches that the coating should not penetrate the mat, and should adhere on the surface of the mat. It would not have been obvious at the time Applicants' invention was made to modify the structure of Horner, Jr. et al. to incorporate attributes that are the opposite of those taught by Horner, Jr. et al.

Claim 38 is dependent on claim 1, and is not anticipated for the same reasons as claim 1. Further, because Horner, Jr., et al. teach away from the features of claim 1 discussed above, claim 38 would not have been obvious over Horner, Jr. et al. at the time Applicants' invention was made either.

Claims 7, 8, 10, 33, 37 and 38 were rejected under 35 U.S.C. § 103 as being unpatentable over Horner, Jr. et al. The Action refers to the additional features recited in the dependent claims as being mere optimization. However, as noted above, Horner, Jr. et al. neither discloses nor suggests that, "the cover layer has a thickness dimension which is substantially uniform," or that, "the cover layer is permanently embedded into the body layer," as required by the base claim 1. Not only does Horner, Jr. et al. fail to disclose these features, but the process disclosed by Horner, Jr. et al. would not have resulted in these features, either. Further, Horner, Jr. et al. teach away from having the cover layer permanently embedded into the body layer, as required by the base claim 1. Therefore, the rejection of claims 7, 8, 10, 33, 37 and 38 should be withdrawn.

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is now in condition for allowance, and request early notification to that effect.

Respectfully submitted,



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